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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135

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EXAMINER

KLINGER, SCOTT M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,249

Applicant(s)

MORI ET AL.

Examiner

Scott M. Klinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-6 are pending.

### *Priority*

A claim for foreign priority has been made. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The effective filing date for the subject matter in the application is 30 August 2000.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Pollack (U.S. Patent Number 6,505,236, hereinafter "Pollack"). Pollack discloses a network-based mail attachment storage system and method. Pollack shows,

In referring to claims 1, 5, and 6,

- Attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail: Pollack, Figure 3, element 156 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means)

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- Attached file transferring step/means for transferring the attached file separated from the electronic mail by the attached file separating means to a predetermined server:  
Pollack, Figure 3, element 158 shows the step of storing the attachment on a specific storage device (which inherently implies an attached file transferring means)
- Store location information adding step/means for adding store location information indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail:  
Pollack, Figure 3, elements 160 and 162 show the steps of generating location information and appending said location to the electronic mail message (which inherently implies a store location information adding means)

In referring to claim 3,

- Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

*"It is a further object of this invention to provide such a system which stores the detached e-mail attachment and appends the body of the e-mail to include a handle which allows the user to retrieve the e-mail attachment at a later time."* (Pollack, col. 1, lines 59-62)

A system that appends a handle, which allows the user to retrieve the e-mail attachment, inherently implies the handle includes the transfer method for retrieving said file

In referring to claim 4,

- The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server:  
Pollack, Figure 3 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold (U.S. Patent Number 6,275,848, hereinafter "Arnold"). Arnold discloses method and apparatus for automated referencing of electronic information. Arnold shows,

In referring to claims 1, 5, and 6,

- Attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail:  
Arnold, Figure 2, element 210 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means)
- Attached file transferring step/means for transferring the attached file separated from the electronic mail by the attached file separating means to a predetermined server:  
Arnold, Figure 2, element 212 shows the step of storing the attachment on a remote site (which inherently implies an attached file transferring means)
- Store location information adding step/means for adding store location information indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail:  
Arnold, Figure 2, element 214 shows the step of substituting the attachment with a pointer (which inherently implies a store location information adding means)

In referring to claim 2,

- Transfer method setting means for setting a transfer method used by the attached file transferring means according to the attribute of an attached file:  
*"The message switch, through the apparatus for automated messaging referencing and sharing of electronic information, applies detachment rules to the e-mail message 206. The detachment rules include criteria for determining whether or not the attachment should be detached from the message 208, thereby enforcing a messaging etiquette. The criteria may include message size, number of recipients, type of recipient (e.g., mobile), where the recipient is located and other configurable factors."* (Arnold, col. 4, lines 9-17)

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In referring to claim 3,

- Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

*“(5) placing the attachment on a remote site; and (6) inserting a pointer into the message, wherein the pointer is linked to the remote site.”* (Arnold, col. 2, lines 36-38)

A system that appends a pointer, which allows the user to retrieve the e-mail attachment, inherently implies the pointer includes the transfer method for retrieving said file

In referring to claim 4,

- The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server: Arnold, Figure 2 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (703) 305-8285. The examiner can normally be reached on M-F 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott M. Klinger  
Examiner  
Art Unit 2153

smk

  
**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**